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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/849,525 08/29/97 LANZENDORFER

G 435-WCG

EXAMINER

HM12/0521

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VENKAT, J

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

05/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/849,525

Applicant(s)
LAZENDORFER ET AL.

Examiner
JYOTHSNA VENKAT

Group Art Unit
1615



☒ Responsive to communication(s) filed on Mar 3, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 8-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 8, 10, 11, 13, and 14 is/are rejected.

☒ Claim(s) 9 and 12 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Receipt is acknowledged of request for correction of filing receipt , preliminary amendment A , and status letter filed on 1/30/98 , 6/30/97 and 3/3/99 .

Claims 1-7 have been canceled and claims 8-14 have been added as per applicants preliminary amendment dated 6/30/97 .

Applicants are notified that the search report has been considered .

Claim Rejections - 35 U.S.C. § 112

1. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression “ and /or “ is indefinite . See *Exparte Aderegg* 51 USPQ 66 .

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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3. Claims 8, 10-11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,723,482 ('482).

See col2 , for carnosine which reads on the flavonoids , urocanic acid reads on the cinnamic acid derivatives , see col6 , lines 25-30 for the antioxidants . The patent at col.1 , teaches that " UV radiation can also lead to photochemical reactions , the photochemical reaction then intervening in skin metabolism and in the immune system and causing photo dermatoses " . This reads on the claimed method " for the treatment of immunosuppression of the skin cells induced by UVB radiation and for protecting the cells " absence of evidence to the contrary . See also col.4 , lines 1-4 , col.5 , lines 15-17 .

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 8, 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Degwert et al. , U.S.Patent 5,723,482 ('482) .

If it can be argued that the claims are not anticipatory , then they are certainly obvious .

The instant application is claiming method for the immunosuppression of the skin cells induced by UVB radiation using (1) one or more flavonoids (2) one or more cinnamic acid derivatives and (3) optionally an antioxidant .

The patent '482 teaches 1 at col.2 , lines 45-64 and 2 at the paragraph bridging cols. 2-3 and antioxidants at col.6 , lines 25-35 . The patent at col.4 teaches that the combination of these agents is active in relevant photochemical induced immunological process . There is direct relation ship between the claimed method and the method disclosed in the patent . Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions having the components 1 and 2 and antioxidants expecting the compounds to be useful for the treatment of immunosuppression of the skin cells induced by UVB radiation as the patent clearly teaches the compounds reduced UV- induced immunomodulation at col.5 , lines 15-18 .

Claims 9 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyothsna Venkat whose telephone number is (703) 308-2439. The examiner can normally be reached on Monday through Friday from 9:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Jyothsna Venkat, Ph. D.
Primary Examiner
AU 1615

jv
May 20, 1999